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10/614,661	07/07/2003	Malvin Schechet	P/130-1	7560
<div>Philip M. Weiss, Esq. Weiss &amp; Weiss Suite 251 300 Old Country Road Mineola, NY 11501</div>				
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EXAMINER				
SOBUTKA, PHILIP				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/614,661

**Applicant(s)**

SCHECHET ET AL.

**Examiner**

PHILIP J. SOBUTKA

**Art Unit**

2618

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5,7-9 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7-9 and 13-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. Claims 1,5,13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darby in view of Pepe et al (US 5,742,668) in view of Paleiov et al (US 6,560,320) and in view of Roeder (US 2002/011176) and in view of Irizarry (US 6,785,566).

Consider claim 1. Darby teaches a handheld wireless device comprising:

telephone, *(Darby teaches the device incorporating mobile phone capabilities as described in paragraphs 10, 16 and 44);*

internet access *(Darby describes the internet capabilities of the device in paragraphs 10, 41,44);* and

video *(Darby teaches the device having video capabilities as described in paragraph 31 and 44);*

wherein said device is connected to a host computer *(Note that, of course, Darby's internet connection would also involve connection to a host computer server. However, Darby's primary teaching is of the device connecting to a call center agent which can be implemented in computer software and displayed as a user selectable animation as described in paragraph 31)*

and said device being protected by a password *(Darby describes the password protection feature in paragraph 27).*

Note that as is well known, both a telephone and internet connection of Darby can be used to provide real time requests for services, furthermore Darby's device provides real-time requests for services *(Darby's device can provide real time requests*

*for information as described in paragraphs 31 and 32, and provides direct sales service as described in paragraph 36).*

Darby lacks a teaching of forwarding emails to the mobile device. Pepe teaches transferring emails from a user home account to a wireless device (*Pepe teaches forwarding of emails to the wireless device in column 23, lines 46-63. Pepe teaches that this is advantageous for users who need to receive emails on their wireless at a visiting location in column 3, lines 20-30*). It would have been obvious to one of ordinary skill in the art to modify Darby to forward emails to the mobile device in order to meet the needs of users who desire to receive emails on their mobiles as taught by Pepe.

Note that Darby's device includes an earpiece (*Darby teaches a speaker earpiece in paragraph 15*) and display panel (*Darby teaches a touch sensitive display in paragraph 15*). Darby lacks a teaching of the display panel being customizable and the device including a stylus. In a similar application arrangement of providing an interactive display unit for telephone services, Paleiov teaches customizable keys (*Paleiov see especially the user display shown in figure 1, as item 38, Paleiov describes the use of custom graphic keys in column 6, lines 15-20 and 55-65*). Paleiov notes that the custom display allows service providers to better construct the graphic applications, allowing for faster more efficient service with enhanced functionality (*Paleiov teaches the advantages of the custom graphic keys providing faster more efficient service with enhanced functionality on column 2, lines 26-45*). It would have been obvious to one of ordinary skill in the art to modify Darby to provide customizable keys in order to allow the service provider to better construct the graphic applications allowing for faster more

efficient service with enhanced functionality as taught by Paleiov. Darby lacks a teaching of the device including a stylus. Note that Paleiov also teaches use of a stylus (*Paleiov see especially column 6, lines 45-55*). It would have been obvious to one of ordinary skill in the art to modify Darby to use a stylus as taught by Paleiov in order to allow the users of the device to more easily pick out the touch sensitive keys.

Darby lacks a teaching of the device being waterproof. Irizarry teaches a waterproof case for a cellular telephone (*Irizarry shows the waterproof case in figure 4 and describes it in column 3, lines 15-65*). Irizarry teaches the case will prevent damage to the phone even during a drop into water (*Irizarry describes the advantages of the waterproof case on column 2, lines 1-25*). It would have been obvious to one of ordinary skill in the art to modify Darby to provide a waterproof case for the device in order prevent water damage even if the device were dropped into water as taught by Irizarry. Note that a case that would prevent entry of liquid would also prevent sand particles from intruding into and damaging the device.

Note that Darby's device has stored in it numbers which would be of interest to a guest. Note that Darby's device is considered for use by hotels (*Darby describes its use as a hotel room information appliance at the end of paragraph 31 and in paragraph 44. Darby teaches the pocket concierge being loaded with the internal phone directories in paragraph 45*). Darby lacks a teaching of the device being loaded with all numbers that would be of interest to a user. It would have been obvious to one of ordinary skill in the art to load the hotel directory with all number that would be of interest in order to increase the usefulness of the device for users.

Darby also lacks a teaching of transferring all calls of a guest from a room phone to said device. Roeder teaches that it is well known to transfer phone call from one phone to another such as a mobile phone (*Roeder describes the well known call forwarding process in paragraph 3. Note that Roeder teaches that the stationary phone could be an internal PBX extension that had its calls forwarded to a mobile device in paragraph 59. Roeder notes that it is advantageous to transfer calls from a stationary phone to a mobile phone when a user is away from the stationary phone in paragraph 12.*). It would have been obvious to one of ordinary skill in the art to modify the arrangement of Darby in view of Paleiov to forward calls from a stationary phone, including an internal PBX extension, such as a hotel room phone to the mobile in order to ensure that the user did not miss calls when they were away from the stationary phone as taught by Roeder.

As to claim 5, Darby's pocket concierge device fits inside a person's pockets. (*Note that Darby's pocket concierge is implemented on a pocket pc as described in paragraphs 10 and 15. Note that of course, pocket PC's are designed to fit inside a person's pocket.*)

As to claim 13, Darby's device can track a person's whereabouts who has possession of said device (*Darby describes the location tracking capability in paragraphs 27 and 33.*)

As to claim 14, Darby's host computer system provides feedback to a user, in response to requests for services. (*Darby's host computer system, i.e. the software*

*implemented call center agent as described in paragraph 31, provides real time responses to a user as described in paragraph 32. Note that the user can also be provided direct sales service as described in paragraph 36).*

As to claim 15, Darby's host computer system provides feedback to a host (Darby's host computer system, i.e. the software implemented call center agent as described in paragraph 31, provides real time responses to a user as described in paragraph 32. Note that user feedback, i.e. the requests for information or direct sales transaction histories can be used by the host to provide follow on marketing as described in paragraphs 36 and 37. Note that the claimed "host" is analogous to Darby's serving call center or service providers).

2. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Darby in view of Pepe et al and in view of Paleiov et al and in view of Roeder and in view of Irizarry and in view of Shaffer et al (US 6,377,798).

Consider claim 3, Darby in view of Paleiov lacks a teaching of the mobile telephone device including a pager. Shaffer teaches a mobile telephone including a pager (Shaffer shows the combined pager and cellular phone in figure 2, and describes it in column 2, lines 58-65). Shaffer teaches that pagers provide mobile communication at lower cost, while using less power than the mobile phone (Shaffer column 1, lines 10-15). It would have been obvious to one of ordinary skill in the art to modify the device of Darby in view of Paleiov to include a pager in order to provide mobile communication at lower cost and lower power consumption, as taught by Shaffer.

3. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darby in view of Pepe et al and in view of Paleiov et al and in view of Roeder and in view of Irizarry and in view of Hase (US 2002/0183078).

Consider claim 7, Darby in view of Pepe et al and in view of Paleiov et al and in view of Roeder and in view of Irizarry fails to teach the device wherein a user's room key functions as an access code to said device. Hase teaches a hand held communicator unit with an ID card functioning as an access code to the device. *(Hase shows the device as a cardholder in figure 2, and in paragraph 36, describes the communication functions of the holder. In paragraph 33, Hase notes that the ID card could be a hotel guest's room key card. Hase describes the use of the ID or room key card to activate the communication device in paragraph 37).* It would have been obvious to one of ordinary skill in the art to modify Darby in view of Pepe et al and in view of Paleiov et al and in view of Roeder and in view of Irizarry to include a storage area for a user's room key as taught by Hase in order to provide the user with a place to keep their room key as well as the security of only allowing use with an appropriately coded ID or room card.

Consider claim 8, Darby in view of Pepe et al and in view of Paleiov et al and in view of Roeder and in view of Irizarry fails to teach the device comprising a storage area for a user's room key. Hase teaches a hand held communicator unit with a storage area for a room key card. *(Hase shows the cardholder in figure 2, and in paragraph 36, describes the communication functions of the holder. In paragraph 33, Hase notes that*



*the ID card could be a hotel guest's room key card*). Hase also teaches that the ID card being held is used as the access code to use the wireless device (*Hase describes the use of the ID or room key card to activate the communication device in paragraph 37*). It would have been obvious to one of ordinary skill in the art to modify Darby in view of Pepe et al and in view of Paleiov et al and in view of Roeder and in view of Irizarry to include a storage area for a user's room key in order to provide the user with a place to keep their room key while also providing the added security of only allowing use of the device with an appropriately coded ID or room card as taught by Hase.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Darby in view of Pepe et al and in view of Paleiov et al and in view of Roeder and in view of Irizarry and in view of Haraguchi et al (US 4,979,205).

Consider claim 9. Darby in view of Pepe et al and in view of Paleiov et al and in view of Roeder and in view of Irizarry lacks a teaching of the device being rechargeable. Haraguchi teaches a well-known type of wireless telephone unit with a rechargeable battery (*Haraguchi shows the cordless unit as item 1 in figure 1 and 6, with the charger built into the base shown as item 2 in figures 1 and 6, and described the use in column 8, lines 53-59*). Haraguchi notes that use of a rechargeable battery lowers the cost of operation over ordinary batteries (*Haraguchi describes the cost benefit of rechargeable batteries in column 8, lines 45-54*). It would have been obvious to one of ordinary skill in the art to modify the wireless telephone of Darby in view of Pepe et al and in view of Paleiov et al and in view of Roeder and in view of Irizarry to use rechargeable batteries

thereby lowering the cost of operation over ordinary replaceable batteries as taught by Haraguchi.

### **Response to Amendment**

5. Since the previous rejection did not properly cite the Irizarry or Pepe references, this action is not being made final.
6. Applicant's arguments filed March 2, 2009 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir.1991).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation for each combination has been provided in the body of the rejections.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are

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based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J Sobotka whose telephone number is 571-272-7887. The examiner can normally be reached Monday through Friday from 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew D. Anderson can be reached on 571-272-4711.

8. The central fax phone number for the Office is 571-273-8300.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number.

**CENTRALIZED DELIVERY POLICY:** For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Philip J Sobutka/

Primary Examiner, Art Unit 2618

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